

REMARKS/ARGUMENTS

Claims 9 and 32-38 are currently pending in the application. This response is being filed along with a Request for Continued Examination (RCE). Claims 1-8, 10-31 and 39-60 were previously withdrawn with traverse and without prejudice as being subject to a restriction requirement. Claims 9 and 32-38 were rejected in the final Office action mailed March 20, 2007 (hereinafter referred to as "Office Action"). A completed credit card authorization form is included for the RCE and the three month extension of time to respond to the Office Action. It is believed that no other fees are due at this time. In view of the following remarks and amendments, applicant respectfully request a timely Notice of Allowance be issued in this case.

Support for the amendments can be found throughout the application. Applicant respectfully submits that no new matter is added by the amendments.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 9 and 32-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith (U.S. Patent 6,529,956). Applicant respectfully submits that claims 9 and 32-38 are not obvious in view of the cited reference and are, therefore, allowable under 35 U.S.C. § 103(a) for the reasons stated below.

The Office Action stated that Smith "does not specifically teach that the document with the secure URL is a web page document, that the request is made before the generation of the secure URL, and that the initial request is the trigger for the process of URL generation. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the ability to have a user-triggered PURL generation to allow for the user to have control if he/she wants to access a certain sensitive document. This would lead to further diversity of the invention, such that secure URLs can be generated on an as-needed basis, but would still be subject to the verification of data access rights. . . . Given that Smith has anticipated the generation of secure URLs using user-information, it would have been obvious to one of ordinary skill in the art to extend this teaching such that the user initiates the generation of the secure URL." (Office Action at 3, lines 9-20). Applicant respectfully disagrees.

MPEP Section 2143.01(V) states that "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Likewise, MPEP Section 2143.01 (VI) states "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious."

Applicant respectfully submits that modifying Smith's invention to "include the ability to have a user-triggered PURL generation" (Office Action at 3, lines 12-13) does not "lead to further diversity of the invention" (Office Action at 3, lines 14-15) and in fact, defeats and is in direct conflict with the stated purpose of Smith's invention. More specifically, the invention disclosed in Smith is a directed document delivery system (Title) designed to "operate[] in a push-fashion" (col. 2, line 16) to "*distribute electronic . . . documents to many recipients* in a controlled, economical and accountable fashion" (col. 2, lines 20-22 (emphasis added); *see also* col. 1, lines 29-34). This is the "technological advance" disclosed in Smith (col. 2, lines 19, 22-23) as further evidenced by claim 1: "*receiving an electronic document for a recipient*; generating a first URL for the recipient, the first *URL generated in response to receiving the electronic document for the recipient*" (col. 18, lines 18-21 (emphasis added)). In fact, Smith refers to the distribution of information through a "pull" type infrastructure as an inherent problem of the Internet (col. 1, lines 24-26) that Smith's invention solves (col. 2, lines 13-17). This purpose is repeated throughout the patent, for example:

. . . intended recipient of a document . . . (Abstract, lines 4 and 6-7; col. 2, lines 30-31 and 33; col. 14, lines 58-59 and 61; col. 15, lines 23-24);

The binary file delivery system 10a enables corporations, publishers and individuals to distribute documents electronically. Importantly, unlike existing World-Wide Web ("Web") based document publishing technologies, the binary file delivery system 10a allows the directed and secure distribution of documents. The World Wide Web ("Web") could currently be characterized as a pull-publishing environment, where the consumer of documents must find and retrieve documents from a server. Push publishing, by contrast, allows the producer of a document to direct the delivery of documents to consumers. Facsimile (fax), the postal service, and electronic mail (E-mail) are all examples of push-publishing. (col. 3, lines 27-39);

. . . enabling the producer of documents to direct where those documents will go. (col. 3, lines 43-44);

. . . can be characterized as a new generation of facsimile technology. (col. 3, lines 51-52);

. . . used for sending a set of binary files from on end-point to one or multiple end-points. (col. 3, lines 61-63);

At the most basic level, a document delivery solution *must enable documents to be directed to customers* by the producers of those documents, or "pushed". (col. 10, line 66-col. 11, line 1 (emphasis added)); and

... it is possible to build a solution that *allows the producer to be the driver, or to push*, but that does not suffer from the limitations and legacy issues associated with SMTP/e-mail. (col. 15, lines 18-21 (emphasis added)).

Based on the foregoing, the proposed modification stated in the Office Action would render the Smith invention unsatisfactory for its intended purpose and would change its principle of operation because: (a) a recipient triggered system is a "pull" type system; (b) Smith's invention is a "push" type system; and (c) Smith is attempting to solve the problems of a "pull" type system by implementing a "push" type system.

As a result, Smith is not sufficient to render claims 9 and 32-38, as amended, prima facie obvious. Accordingly, applicant respectfully submits that claims 9 and 32-38, as amended, are allowable under 35 U.S.C. § 103(a).

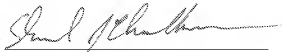
Conclusion

For the reasons set forth above, applicant respectfully requests reconsideration by the examiner and withdrawal of the rejections. Applicant submits that claims 9 and 32-38 are fully patentable. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If the examiner has any questions or comments, or if further clarification is required, it is requested that the examiner contact the undersigned at the telephone number listed below.

Date: September 20, 2007

Respectfully submitted,

CHALKER FLORES, LLP

By 

Daniel J. Chalker
Reg. No. 40,552
Tel.: (214) 866-0001
Fax: (214) 866-0010

2711 LBJ Freeway
Suite 1036
Dallas, Texas 75234